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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/011,691	02/13/98	PHELAN	S PMS245063

PILLSBURY MADISON & SUTRO  
1100 NEW YORK AVENUE NW  
NINTH FLOOR  
EAST TOWER  
WASHINGTON DC 20005-3918

PM82/0918

EXAMINER

MARC COLEMAN, M

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 09/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/011,691

Applicant(s)

PHELAN, SEAN

Examiner

Marthe Y. Marc-Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-37 and 50-53 is/are allowed.
- 6) ☒ Claim(s) 30-32, 38-44, 46-48 and 54-66 is/are rejected.
- 7) ☒ Claim(s) 33, 45, 49 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All   b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This office action is responsive to applicant's amendment filed on 7/24/00.

#### *Claim Objections*

2. Claims 30, 34, 35 and 65 are objected to because of the following informalities:

In regard to claims 30, 34, 35 and 65, "utilising the map" should be replaced by "utilizing the map".

In regard to claim 46, "an second" should be replaced "a second".

Appropriate correction is required

#### *Specification*

3. The disclosure is objected to because of the following informalities: on page 3 line 19 "utilising the map" should be replaced by -- utilizing the map -- .

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

4. Claims 30-33, 38-49, 54-62 and 65 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because "storing on a second information server computer" makes the claim confusing

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since applicant does not indicate a previous information server computer or a first information server computer

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. As best understood by the Examiner, claims 30-32, 40-44, 46-48, 56, and 63-66 are rejected under 35 U.S.C. 102(a) as being anticipated by Bouve et al. (U.S. Patent No. 5,682,525).

In regard to claims 30, 46 and 63-66, Bouve et al. disclose:

- storing on a map server computer map data representing of a map of a geographical area (see col. 2 lines 13-17);
- storing on the map server computer coordinates of at least one point associated with the geographical area represented by the map so as to enable correlation of points on the map with their corresponding geographical location (see abstract and col. 2 lines 10-17, lines 44-52);
- storing on an information server computer information data relating to at least one place of interest within the geographical area, said information data including data representative of the spatial coordinates of the place of interest within the area (see col. 12 lines 24-27);
- transmitting a map request to the map server computer from a client computer and transmitting from the map server computer to the client computer in response to the map request the map data (see col. 3 lines 14-22, and col. 12 lines 28-34).

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- utilizing map data to be displayed on a screen (col. 1 lines 48-53 and col. 5 lines 2-13);
- transmitting an information request to the information server computer from the client computer and transmitting from the information server computer to the client computer in response to the information request the information data relation to at least one place of interest (see col. 3 lines 14-22 and col. 12 lines 28-34);

displaying the information data relating to at least one place of interest on the visual display unit (see Fig. 1).

In regard to claims 31, 32, 47, and 48, Bouve et al. discloses:

- map information request transmitted before information request, information request is transmitted before map request (see abstract).

In regard to claim 40, Bouve et al. disclose:

- storing on the map server computer a list of categories of places of interest (see col. 2 lines 10-21);
- retrieving the list with the map data and displaying on the visual display unit a respective icon for each said category (see col. 2 lines 45-63 and Fig. 3).

In regard to claim 41, Bouve et al. disclose that the request is effective by activation of a respective icon on the visual display unit (see Fig. 3 and col. 13-64).

In regard to claims 42 and 56, Bouve et al. disclose a computer system wherein the client computer includes locating means for establishing the current geographical location of the client computer and means for passing the current geographical location

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of the client computer to at least one of the map server computer and the information server computer (see abstract and col. 12 lines 8-65).

In regard to claims 43 and 44, Bouve et al. disclose that the locating means uses the global positioning system, the locating means includes a cellular telephone (see col. 5 line 63 - col. 6 line 11 and Fig. 6B).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 38, 39, 54, 55, 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al. (U.S. Patent No. 5,682,525) in view of Arikawa (XP 000612712).

In regard to claims 38, 39, 54 and 55, Bouve et al. meet the limitations of claim 30 but do not specifically disclose means for zooming the map image in or out to display an image of, respectively, a smaller or larger geographical area, and means for varying the displayed data relating to the at least one place of interest on the visual display unit so as to take account of the smaller or larger geographical area. They do not specifically disclose that the client computer includes means for formulated a further request to the information server, to identify places of interest lying within the smaller or larger geographical area. These teachings are taught by Arikawa (see page 595 section 4.2 fourth paragraph and sixth paragraph and Fig. 9 and Fig. 4).

At the time of the invention, it would have been obvious to one skilled in the art to utilize Arikawa's zooming means with Bouve et al.'s computer system because it would provide users with more flexible, specialized and reliable information (see Arikawa page 591 col. 2).

In regard to claims 57-62, Bouve et al. meet the limitations of claims 30 and 46, but do not specifically disclose that the computer communicated with the map server computer and the information server computer via a World Wide Web. And that the displaying of the information on the video display unit is performed by using an Internet browser wherein the map data transmitted from the map server computer is an image file.

These teachings are taught by Arikawa (see page 591). Although, it seems like Arikawa teaches away from the invention, it is well known in the art, that at the time the invention was made geographic information servers are connected to the Internet and thus provide geographical information to an unspecified number of clients.

At the time of the invention, it would obvious to one skilled in the art to utilize Arikawa's maps based on information servers with Bouve et al.'s computer system so that more flexible, specialized and reliable map information can be obtained (see Arikawa page 591).

9. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure . Philip Davis (XP 000612268), Shimizu, Toshihiko (EP 0539 143), Kosaka et al. (U.S. Patent No. 5,748,109), Craport et al. (U.S. Patent No. 5,796,634) and Rogers et al. (U.S. Patent No. 5,701,451) are cited to further show the state of the art with respect to computer system for a geographical map.

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***Allowable Subject Matter***

10. Claims 33, 45 and 49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 34-37, and 50-53 are allowable.

The following is a statement of reasons for the indication of allowable subject matter:

In regard to claims 33, 49 and 34-37, and 50-53, none of the references, either singularly or in combination, teach or fairly suggest:

"superposing information relating to the place of interest on the image on the visual display unit, at a position on the image on the visual display unit, at a position on the image corresponding to the location of the place of interest on the map."

In regard to claim 45, none of the references, either singularly or in combination, teach or fairly suggest:

" means for superimposing on the image an icon indicative of the current geographical location."

***Response to Arguments***

11. Applicant's arguments filed on 7/24/00 have been fully considered but they are not persuasive. Applicant argues "Bouve is entirely different from the claimed invention in that Bouve discloses using a single database storage memory 139 for holding both map data and information relating to items of interest." Examiner disagrees, Bouve also disclose an additional database storage 139a (see col. 12 lines 24-27).



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**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc-Coleman Marthe whose telephone number is (703) 305-4970. The examiner can be reached from Monday through Friday 6:30AM to 4:00PM.

If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to Group Receptionist whose telephone number is (703) 308-1111.

**Any response to this action should be mailed to :**

Commissioner of Patents and Trademarks

Washington, D. C. 20231

**or faxed to :**

(703) 308-8623, (for formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park V, 2451 Crystal drive, Arlington, VA., Seventh Floor (Receptionist).

Patent Examiner

*MYM*  
Marc-Coleman Marthe

September 12, 2000

  
WILLIAM A. CUCHLINSKI, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600